



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,211	11/18/2003	Barry Appelman	06975-455001	2240
26171	7590	01/08/2008	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			WALSH, JOHN B	
		ART UNIT	PAPER NUMBER	
		2151		
		MAIL DATE	DELIVERY MODE	
		01/08/2008	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

MN

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/715,211	APPELMAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	John B. Walsh	2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-57 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-57 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 18 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/9/04;9/22/04;6/27/06;5/3/07</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 57 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 57 recites a computer program stored on a signal. A signal is not a proper computer readable storage medium. The claims fail to place the invention squarely within one statutory class of invention. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 7, 12, 14, 16-18, 22, 30, 38, 55-57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 5 of U.S. Patent No. 6,750,881. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '881 claims anticipate the claims of the present application, wherein the online context corresponds to the logon status.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 4-7, 12-25, 28-30, 32, 34, 35, 37-44, 49-52, 55, 56 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,299,257 to Boyer et al.

As concerns claims 1, 30, 56 and 57 as best understood, a method of informing dynamically a user of a large scale network of other network users, the method comprising: determining dynamically an online context of the user (429,908; col. 21, lines 50-60); identifying other users (col. 21, lines 43-46) presently within the online context of the user; storing trait

information (figures 4 and 8) related essentially only to the user or to the other users in a users store related to the online context; and informing the user (col. 21, lines 50-60; col. 22, lines 9-  
11) dynamically of the other users based on the stored trait information.

As concerns claim 2, the method of claim 1 wherein determining an online context of the user comprises determining an Internet domain currently accessed by the user (col. 22, line 29).

As concerns claim 4, the method of claim 1 wherein determining an online context of the user comprises determining a message board (col. 22, line 20-chat, email) currently accessed by the user.

As concerns claim 5, the method of claim 1 wherein determining an online context of the user comprises determining a URL currently accessed by the user (col. 22, line 29).

As concerns claim 6, the method of claim 1 wherein determining an online context of the user comprises determining an online context on which the user presently is focused (col. 21,  
lines 43-60).

As concerns claim 7, the method of claim 1 wherein identifying other users presently within the online context of the user comprises dynamically identifying users who enter the online context and users who leave the online context (col. 21, lines 50-60; col. 22, lines 9-11).

As concerns claim 12, the method of claim 1 wherein the trait information comprises information related to a participation status (429,908; col. 21, lines 50-60) of the user or of another user.

As concerns claim 13, the method of claim 12 wherein the information related to the participation status comprises a visibility preference (status is visible, displayed) of the user or of the other user.

As concerns claim 14, the method of claim 12 wherein the information related to the participation status comprises information defining the participation status (figure 10) of the user or of the other user based on multiple online contexts.

As concerns claims 15 and 32, the method of claim 1 wherein the trait information comprises trait information of an individual selected as an associate (associate of the group; col 23, line 24) by the user or by another user.

As concerns claim 16, the method of claim 1 wherein the trait information comprises information related to an online status (429,908; col. 21, lines 50-60) of the user or of another user.

As concerns claim 17, the method of claim 16 wherein the online status comprises a status of active, idle, away, and/or mobile (429,908; col. 21, lines 50-60; figure 9).

As concerns claim 18, the method of claim 1 further comprising storing other information related essentially only to the user or to the other users in the users store related to the online context; and informing the user (figure 9, 908; figure 8) dynamically of the other users based on the stored other information.

As concerns claims 19 and 29, the method of claims 18 and 1 wherein the other information comprises information indicative of an identification (figure 8, 419) of the user or of an other user.

As concerns claim 20, the method of claim 19 wherein the information indicative of an identification comprises an online identifier (429,908; col. 21, lines 50-60) associated with the user or with the other user.

As concerns claim 21, the method of claim 18 wherein the other information comprises contact information (fig. 8, 419; fig. 9, 428) of the user or of another user.

As concerns claim 22, the method of claim 18 wherein the other information comprises information based on an activity level (figure 10; 1013; 1001-2; figure 9; 908 ) associated with the online context.

As concerns claim 23, the method of claim 22 wherein the users store is migrated based on the activity level (fig. 7 and 10; migrated when created to be stored).

As concerns claim 24, the method of claim 22 wherein the users store is divided based on the activity level (fig. 7, 415; divided from other data).

As concerns claim 25, the method of claim 22 wherein the users store is combined with a related users store based on the activity level (fig. 10; 423).

As concerns claim 28, the method of claim 1 wherein informing the user dynamically of the other users comprises informing the user of a total number (figure 11; 419) of the other users.

As concerns claim 34, the method of claim 1 wherein informing the user dynamically of the other users comprises displaying (figures 8-10; col. 21, line 50) to the user information indicative of another user based on the stored trait information.

As concerns claims 35 and 37, the method of claim 34 wherein a trait and identity of the other user is indicated graphically (figures 8-10; col. 21, lines 50-55).

As concerns claim 38, the method of claim 1 further comprising enabling the user to communicate (col. 22, lines 1-8) with at least one of the other users of which the user is informed.

As concerns claim 39, the method of claim 38 wherein enabling the user to communicate with at least one of the other users of which the user is informed comprises enabling the user to send an instant message (col. 22, line 20) to the at least one of the other users.

As concerns claim 40, the method of claim 38 wherein enabling the user to communicate with at least one of the other users of which the user is informed comprises enabling (enabling is not a positive limitation, only the ability to perform, since enabling sending of an email does not actually require the email being sent) the user to send an email (col. 22, line 20) to the at least one of the other users.

As concerns claim 41, the method of claim 38 wherein enabling the user to communicate with at least one of the other users of which the user is informed comprises enabling the user (enabling is not a positive limitation, only the ability to perform, since enabling use of voice communication does not actually require the communication to take place) to contact directly the at least one of the other users using a voice communication (col. 22, line 20).

As concerns claim 42, the method of claim 40 wherein the voice communication employs a mobile device (503, col. 13, line 42).

As concerns claim 43, the method of claim 38 wherein enabling the user to communicate with at least one of the other users of which the user is informed comprises enabling the user to store contact information of the at least one of the other users to a contact list (404, figure 8) of the user.

As concerns claim 44, the method of claim 43 wherein the contact list of the user comprises a buddy list (404, figure 8).

As concerns claim 49, the method of claim 1 wherein informing the user dynamically of the other users comprises informing the user only of other users associated with trait information of the user (col. 23, lines 21-43-group).

As concerns claim 50, the method of claim 49 wherein the trait information comprises information indicative of a location (col. 23, lines 36) related to the user.

As concerns claim 51, the method of claim 1 wherein informing the user dynamically of the other users comprises providing updated information (col. 22, line 11); user makes a change thus affects the reason for an update and the interval) based on a user designated interval.

As concerns claim 52, the method of claim 1 wherein informing the user dynamically of the other users comprises providing updated information (col. 22, line 11) based on a system designated interval.

As concerns claim 55, the method of claim 1 further comprising: detecting dynamically a changed online context of the user (429,908; col. 21, lines 50-60); identifying changed context users presently within the changed online context of the user (col. 22, lines 11); storing second trait information related essentially only to the changed context users in a changed users store (figures 4 and 8); and informing the user dynamically of the changed context users based on the stored second trait information (col. 22, lines 9-11).

#### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,299,257 to Boyer et al. as applied above.

Boyer et al. '257 do not explicitly disclose wherein providing updated information about every 15 seconds and about every 60 seconds.

Such times are seen as an obvious design choice to one having ordinary skill in the art since the invention would work equally well with alternate times (i.e. 25 seconds) and no particular significance has been established for this distinct times.

9. Claims 8-11, 26, 27, 31, 33, 36, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,299,257 to Boyer et al. as applied above in view of U.S. Patent No. 6,434,599 to Porter.

Boyer et al. does not explicitly disclose the particular claim limitations.

Porter '599 teach:

As concerns claim 8, 27 and 46, wherein the trait information comprises information related an age (fig. 6A) of the user or of another user.

As concerns claims 9, 26 and 47, wherein the trait information comprises information related to a demographic identifier (figure 6A) of the user or of another user.

As concerns claims 10 and 33, wherein the trait information comprises information related to an expertise rating (figure 6A-interests) of the user or of another user.

As concerns claims 11, 31 and 36, the method of claim 1 wherein the trait information comprises information related to an interest (figure 6A) of the user or of another user.

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the particular trait information, as taught by Porter '599, in order to provide a means of providing more information about users to enhance communication.

10. Claims 45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,299,257 to Boyer et al. as applied above in view of U.S. Patent No. 5,960,173 to Tang et al.

Boyer et al. do not explicitly disclose sorting.

Tang et al. '173 teach sorting (figure 4,27).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the system of Boyer et al. with sorting, as taught by Tang et al. '173, in order to allow the user to be presented the most relevant information desired in an organized manner.

As concerns claim 48, the method of claim 45 wherein the trait information comprises preference (see Boyer et al. 206) information of the user.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,299,257 to Boyer et al. as applied above in view of U.S. Patent No. 6,480,885 to Olivier.

Boyer et al. '257 do not explicitly disclose newsgroups.

Olivier '885 teaches newsgroups (abstracts).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide access to newsgroups, as taught by Olivier '885, in order to provide an

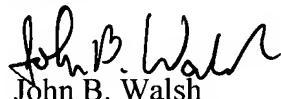
additional means of communicating, thus increasing the redundancy of the communication system.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000..

  
John B. Walsh  
Primary Examiner  
Art Unit 2151